

### **REMARKS**

In the Office Action the Examiner noted that claims 1-8 are pending in the application, and the Examiner rejected all claims. By this Amendment, claims 1-8 have been amended, and new claims 9-11 have been added. No new matter has been presented. Thus, claims 1-11 are pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

#### **Entry of Amendment Under 37 C.F.R. §1.116**

The Applicant requests entry of this Rule 116 Response because: the amendments were not earlier presented because the Applicant believed in good faith that the cited references did not disclose the present invention as previously claimed; the amendment of claims 1-8 and addition of claims 9-11 should not entail any further search by the Examiner since no new features are being added and no new issues are being raised; and the amendments do not significantly alter the scope of the claim, and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

#### **Claim Objections**

On page 3 of the Office Action the Examiner objected to claim 1 because of an informality, and stated that the language "a" should be inserted before the word "into" in line 7 of claim 1.

By this Amendment, claim 1 has been amended, and the language objected to by the Examiner is no longer present in the form which was objected to. Therefore, the Applicants respectfully request the withdrawal of the Examiner's objection to claim 1.

Claim Rejections Under 35 USC §112

On pages 3-6 of the Office Action the Examiner rejected claims 1-8 under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner identified several alleged problems with the language recited in these claims.

By this Amendment, claims 1-8 have been amended, and the Applicants respectfully submit that these claims are proper under 35 U.S.C. §112, second paragraph. Therefore, the Applicants respectfully request the withdrawal of the Examiner's §112 rejections.

Claim Rejections Under 35 USC §103

On pages 6-8 of the Office Action the Examiner rejected claims 1, 4, 7, and 8 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,052,709, issued to Paul (hereinafter referred to as "Paul") in view of U.S. Patent No. 6,615,348, issued to Gibbs (hereinafter referred to as "Gibbs"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Claim 1 of the present application, as amended, recites "determining whether a first address indicated by an electronic mail transmitted from a client through the network indicates the second address recorded in the address table for mail virus detection, the first address being registered in an address book of the client." The Applicants respectfully submit that neither of the cited references, either alone or in combination, disclose or suggest at least these features of claim 1.

Paul discloses a method of detecting unsolicited (spam) electronic mail by creating and planting one or more spam probe email addresses at various sites on a communications network (Column 1, Lines 60-64). When an electronic mail is addressed to one of these spam probe email addresses, a spam control center automatically analyzes the received electronic mail to identify the source of the message, extracts and processes the source data from the received message, and generates an alert signal containing the processed source data (Column 2, Lines 1-6). Therefore, the spam emails are addressed to email addresses which are not used by clients, and are only intercepted when incoming to the clients of the system.

This is in direct contrast to "determining whether or not a first address indicated by an electronic mail transmitted from a client through the network indicates the second address recorded in the address table for mail virus detection," as is recited in claim 1 of the present

application. In Paul, the intercepted spam emails are not transmitted from a client, but are transmitted from a previously unknown source. Indeed, the goal of the Paul disclosure is to identify the source of the spam email (Column 2, Line 3). Therefore, Paul does not disclose at least this feature of claim 1.

Further, claim 1 also recites "the first address being registered in an address book of the client." This is also in direct contrast to both the disclosure and the purpose of the method of Paul. Because Paul is attempting to stop the delivery of spam email to clients of the service, the addresses to which the spam emails are addressed (which the Examiner has characterized as the first address) are not affiliated with any actual clients at all, but are simply "dummy" addresses set up so that the spam emails and spam email sources can be identified without a client being involved in the email transaction at all.

For example, in the system disclosed in Paul, if a mail virus were to be introduced to a client through an email addressed solely to that client (such as from a known source, or simply from a source which has not sent email to the spam probe email address), the mail virus could be spread to everyone in that client's address book through emails sent from the client. However, with the method recited in claim 1, the virus email from the client having the first address corresponding to the second address recorded in an address table for mail virus detection would be suppressed, and therefore not spread.

Also, claim 1 recites "registering a second address as a receiver address in an address table for mail virus detection." This is also in direct contrast to both the disclosure and the purpose of the method of Paul, which stores sender address information, regarding the sender of spam email after the identification of the source of the spam email, in order to generate the alert signal containing the source data. In other words, while claim 1 of the present application recites registering the receiver address in an address table for mail virus detection, Paul registers a sender address pertaining to a sender of spam email. The second address registered in the address table of the present application is a receiver address used for mail virus detection, not a sender address used to transmit an email virus, and certainly not a sender address used to send spam email, as is contemplated and disclosed by Paul. In an example embodiment enabled by the features recited in claim 1 of the present application, the registered receiver address can be an address which is not used regularly as a receiver address in email sent from the client, and is therefore easily recognized as being generated due to a virus infection in the client's computer.

Therefore, the Applicants respectfully submit that Paul does not disclose or suggest at

least the features of claim 1 discussed at length above. Further, as Gibbs apparently merely discloses that spam email sometimes includes viruses, the deficiencies of Paul in regard to claim 1 are not cured by Gibbs. For a proper §103 rejection, the cited references must disclose all of the recited features of the rejected claim. Thus, as neither Paul nor Gibbs, either alone or in combination, disclose or suggest at least these discussed recited features of claim 1, it is respectfully submitted that claim 1 patentably distinguishes over the cited references.

Further, the Applicants respectfully submit that even if, *arguendo*, the cited references did disclose all of the features of claim 1, there is no motivation to combine the cited references. MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." Here, the Examiner has simply stated, with no evidence to support the assertion, that "it would have been obvious to one of ordinary skill in the art to utilize Paul's teachings in an email virus detection system such that any spam message detected is assumed to contain a virus. One skilled would have been motivated to do so because as Gibbs discloses, spam messages often contain viruses." The Applicants respectfully submit that the simple fact that spam sometimes contains viruses does not provide the requisite motivation. Also, the Examiner stated that "One skilled should appreciate that in such instances, spam messages and virus messages are one in the same." However, quite to the contrary, to characterize all spam messages as virus messages is simply without any reasonable foundation. This would be tantamount to referring to any email from a friend, which was sent without your "solicitation", as spam. The Applicants respectfully submit that the mere fact that Gibbs discloses that spam emails sometimes contain viruses does not provide motivation for the Paul method to also screen for viruses. The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Further, even if the cited references were combined so that, as stated by the Examiner, “[u]tilizing Paul’s teachings to prevent a possibly infected spam message from being delivered to a user would cause the user’s network to be more secure and prevent a user from accidentally activating a virus that was attached to a spam message,” simply stopping the spam email from being sent does not disclose “storing information concerning the electronic mail as mail virus information in a mail virus information table..., and suppressing transmission of any electronic mail including the mail virus”, as is recited in claim 1 of the present application.

Therefore, for all of the reasons presented above, it is respectfully submitted that claim 1 patentably distinguishes over the cited references, and the withdrawal of the Examiner’s rejection of claim 1 is respectfully requested.

Claim 8 depends from claim 1 and includes all of the feature of that claim plus additional features which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claim 8 also patentably distinguishes over the cited references.

Claim 4 of the present application, as amended, recites “determining whether a first address indicated by an electronic mail transmitted from a client through the network indicates the second address recorded in the address table for mail virus detection, the first address being registered in an address book of the client.” As discussed above in regard to claim 1 of the present application, none of the cited references disclose or suggest at least these features of claim 4. Therefore, it is respectfully submitted that claim 4 also patentably distinguishes over the cited references.

Claim 7 of the present application, as amended, recites “detecting an electronic mail as being infected by a virus in response to determining that a first address of an electronic mail transmitted from a client corresponds to a second address recorded in an address table for virus detection, the first address being registered in an address book of the client.” As discussed above in regard to claim 1 of the present application, none of the cited references disclose or suggest at least these features of claim 7. Therefore, it is respectfully submitted that claim also patentably distinguishes over the cited references.

On pages 9-11 of the Office Action the Examiner rejected claims 2-3 and 5-6 under 35 U.S.C. §102(a) as being unpatentable over Paul in view of Gibbs, and further in view of U.S. Patent No. 6,898,715, issued to Smithson et al. (hereinafter referred to as “Smithson”). The Applicants respectfully traversed the Examiner’s rejections of these claims.

As previously discussed in this Amendment, claims 1 and 4 patentably distinguish over

Paul and Gibbs. Further, as Smithson apparently merely discloses reporting the detection of a mail virus to a predetermined report address, Smithson does not cure the deficiencies of Paul and Gibbs in regard to claims 1 and 4. Therefore, as claims 2-3 depend from claim 1, and claims 5-6 depend from claim 4, and these dependent claims include all of the features of their respective independent claims plus additional features which are not disclosed or suggested by the cited references, it is respectfully submitted that claims 2-3 and 5-6 also patentably distinguish over the cited references.

Further, the Applicants respectfully submit that there is no motivation to combine Smithson with Paul, because, as stated previously in this Amendment, there is also no motivation to combine Gibbs with Paul, as Paul does not contemplate detecting nor reporting viruses, but merely spam emails.

#### New Claims 9-11

New claims 9-11 depend from claim 7 and include all of the features of that claim plus additional features which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claims 9-11 also patentably distinguish over the cited references.

#### Summary

In accordance with the foregoing, claims 1-8 have been amended, and new claims 9-11 have been added. No new matter has been presented. Thus, claims 1-11 are pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 08/09/06

By: Thomas L. Jones  
Thomas L. Jones  
Registration No. 53,908

1201 New York Avenue, NW, 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501